

REMARKS

Claims 1-31 are pending. Claims 1-18 and 26-31 stand allowed, and claims 19-25 stand rejected. By this Amendment, claim 19 is amended. Support for the amendment is found in the application, as originally filed. It is submitted that amended claim 19 does not add new matter.

It is noted that the Office Action (Office Action Summary) indicates both (1) that claims 21-31 are allowed and (2) that claims 19-25 are rejected. Applicants understand that that this was a typographical mistake and assumed that Examiner rejected claims 19-25 throughout this reply. Please let the undersigned know if the above assumption is not correct.

The Office Action rejects claims 19-25 under 35 USC 103(a) as being unpatentable over U.S. Patent Publication 2004/00969820 of Barnea et al. If applicable to amended claim 19, and claims 20-25 dependent on claim 19, this rejection is respectfully traversed.

Barnea et al. does not disclose, teach or suggest all of the features specified in amended claim 19. For example, Barnea et al. does not disclose, teach or suggest:

a mass spectrometer [that generates] multiple spectra collected at varying collision energies for an unknown compound; and

a computer for creating a composite spectrum from said multiple spectra, said composite spectrum indicating a pseudo molecular ion and fragment ions, [and] for assigning a degree of importance to ion ratios depending upon the identity of said ions,

as specified in claim 19, and therefore contained in claims 20-25 dependent on claim 19.

In fact, under the section titled Allowable Subject Matter the Office Action states that:

the prior art fails to disclose or make obvious a method for accounting for adducts in mass spectrometer spectra for library searching comprising collecting multiple spectra at varying collision energies and creating a composite and reduced spectrum.

Accordingly, withdrawal of the rejection of claim 19-25 is earnestly solicited.

The United States Supreme Court established the basic rules for analyzing the obviousness of a patent claim and articulated three factual inquiries to be made in an obviousness determination. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). This analysis requires a factual inquiry into (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed subject matter, and (3) the level

of skill of a person of ordinary skill in the art at the time the invention was made. The M.P.E.P. instructs that “examiners should apply the test for patentability under 35 U.S.C. §103 set forth in *Graham*.” See M.P.E.P. 2141 through 2143. In the present application, the scope and content of the applied prior art is limited to U.S. Patent Publication 2004/00969820 of Barnea et al., and Barnea et al. does not disclose the specific features specified in claim 19.

To establish a case of obviousness based on a modification of a base reference, the Patent and Trademark Office must demonstrate by substantial evidence that the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, contains some suggestion or incentive that would have motivated an ordinarily skilled person to modify the subject matter of a reference or combine the subject matters of the references to achieve the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). M.P.E.P. 2143.01 instructs that “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” “[T]he central question is whether there is reason to combine [or modify] references,” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). “[A] showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’,” *Brown and Williamson Tobacco Corp. v. Phillip Morris Inc.*, 229 F.3d 1120, 1124-1125, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000). “[T]here must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant,” *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). In the present application, U.S. Patent Publication 2004/00969820 of Barnea et al. does not disclose motivation to modify its structure to achieve the specific features specified in claim 19.

Motivation must be found with specificity. “[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention would have selected these components for combination in the manner claimed,” *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Establishment of a suggestion or incentive to modify or combine prior art references requires substantial evidence of such suggestion or incentive. “The factual question of motivation is material to patentability, and

could not be resolved on subjective belief of unknown authority," *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002).

In view of the above, favorable reconsideration and prompt allowance are courteously requested. If there are any remaining issues that can be expedited by a telephone conference, the examiner is courteously invited to telephone counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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